REMARKS/ARGUMENTS

Claims 71-79 and 93-112 remain in the application for further prosecution. Claims 71, 93, 102, and 109 have been amended. Although these amendments are being made after a final office has been issued, the Applicants respectfully request that the amendments be entered because they present the "rejected claims in better form for consideration on appeal." Manual of Patent Examining Procedure ("MPEP"), Eighth Ed., Rev. 6, Sept. 2007, § 714.12, p. 700-260. Specifically, the claims have been amended to include in the body of the claim elements already included in the preamble of the claim.

I. § 103 Rejections

Claims 71-79, 93-109, and 111-112 have been rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over U.S. Patent No. 7,267,614 to Jorasch *et al.* ("Jorasch") in view of U.S. Patent No. 7,071,845 B2 to Ivancic ("Ivancic"). Claim 110 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jorasch.

II. Problems Related To The Final Office Action

A. Final Office Action Has Failed To Address Independent Claim 102

The Final Office Action has failed to address any claim elements of this claim. Accordingly, the Applicants respectfully submit that claim 102, along with all the claims dependent therefrom, are patentable and should be in condition for allowance.

Alternatively, if the Final Office Action has inadvertently failed to address the elements of claim 102, the Applicants respectfully submit that a new office action must be issued to properly address the elements of claim 102.

B. Rejection Of Claim 110 Is Improper

Claim 110 is dependent on claim 109. However, although claim 109 has been rejected based on Jorasch and Ivancic, claim 110 has been rejected solely on Jorasch. The Applicants respectfully submit that this rejection is improper and, in fact, does not make sense.

The Final Office Action alleges that "Jorasch teaches all the present invention as shown above but fail [sic] to specifically teach a legend plate ...." Final Office Action, p. 4. But earlier, referring to claim 109, the Final Office Action acknowledges that "Jorasch fails to teach wherein the button is physically mounted on or within a gaming machine." Final Office Action, p. 2.

Accordingly, the Applicants respectfully submit that claim 110 is patentable over Jorasch at least because the Final Office Action explicitly admits that "Jorasch fails to teach wherein the button is physically mounted on or within a gaming machine." Alternatively, if the Final Office Action has inadvertently failed to properly reject claim 110, the Applicants respectfully submit that a new office action must be issued to properly address the rejection of claim 110.

C. Final Office Action Has Failed To Address Elements Of Claims 111-112

Claim 111 is directed to a "plunger-spring assembly" that transmits a linear motion to the sensor. Claim 112 is directed to a sensor selected from a group "consisting of a micro-switch, a Hall-effect sensor, an optic sensor, an eddy current sensor, a resistive sensor, a piezo sensor, and

a strain gage sensor." The Final Office Action has completely failed to address any of these claim elements.

The Applicants respectfully submit that claims 111 and 112 are patentable and should be in condition for allowance. Alternatively, if the Final Office Action has inadvertently failed to address the elements of claims 111 and 112, the Applicants respectfully submit that a new office action must be issued to properly address these claim elements.

III. Jorasch And Ivancic Fail To Disclose The Claimed Game Button

The pending claims are directed to a game button that is "physically mounted on or within a gaming machine to receive selections related to a wagering game." None of Jorasch or Ivancic discloses the claimed game button. In fact, the Applicants respectfully submit that comparing the claimed game button to the gaming token 208 of Jorasch or to any of the buttons or keys 14, 24, 34, 44 of Ivancic (*e.g.*, keyboard buttons, mobile phone buttons, remote control buttons) is like comparing apples and oranges.

Pursuant to previous discussions with the Examiner, the claims had been previously amended to clarify the exact type of distinction that distinguished the claimed game button from the gaming token 208 of Jorasch and the buttons 14, 24, 34, 44 of Ivancic. *See* Response to Second Office Action of July 9, 2008, pp. 9-10.

Each independent claim is directed to "button that is physically mounted on or within a gaming machine to receive selections related to a wagering game." Although this claim element has been included in the preamble of each claim in accordance with discussions and approval of the Examiner, the claims have been further amended for appeal purposes to include the claim elements in the body of the claim, as well.

A. Jorasch Fails To Disclose A Game Button

Jorasch discloses a gaming token 208 (illustrated in FIG. 3) that has a variable value and that can be inserted or dispensed from a gaming device. Jorasch, col. 1, ll. 46-62. The gaming token 208 has a plurality of electronic components 400, including a processor 402. *Id.* at col. 6, ll. 65-67. The Applicants respectfully submit that characterizing the gaming token 208 of Jorasch as a "game button" completely ignores the entire disclosure of Jorasch, as well as previous discussions with the Examiner. For example, the Examiner has already agreed that the token disclosed by Jorasch is not a game button. *See* Response to Second Office Action of July 9, 2008, pp. 9-10. Nevertheless, the current Final Office Action again alleges that Jorasch teaches a "game button."

As previously discussed (and agreed) with the Examiner, the gaming token 208 of Jorasch cannot be the same as the claimed game button. The gaming token 208 is generally a substitute for currency, *e.g.*, it is similar in its physical embodiment and purpose to coins. Jorasch discloses, for example, that a hopper controller 545 "controls the dispensing of tokens and/or currency by slot machine 204 to hopper 548," wherein the "hopper controller 545 is connected to the hopper 548 for the purpose of dispensing tokens and/or coins." Jorasch, col. 8, ll. 56-59. A game button that is physically mounted on a gaming machine cannot be interpreted to be the same as a token or a coin.

Furthermore, the Final Office Action alleges that the "Jorasch invention, when taken as a whole, shows a device that includes a display information which displays information related to a wagering game." Final Office Action, p. 2 (emphasis added). Ironically, this description of Jorasch fails to consider the gaming token 208 "taken as a whole." The gaming token 208, taken

as a whole, is a device that is not physically mounted (or intended to be mounted) on a gaming machine. Consistent with Jorasch, the gaming token 208 is more like loose coins than a game button physically mounted on a gaming machine.

B. Ivancic Fails To Disclose A Processor or A Memory In a Game Button

The Final Office Action alleges that "Ivancic's invention (see figs 4-5) shows that one of ordinary skill in the art is more than capable of placing a device and its processor in a place that is generally subjected to physical 'pounding' by the users." However, a careful review of Ivancic shows that the disclosed processor 51 is not located "in a place that is generally subjected to physical 'pounding' by the users." Referring to FIG. 5 of Ivancic, it is clear that the processor 51, as well as key display memory 53 and the key configuration memory 54, are located away from the key displays 57 (*i.e.*, away from keyboard keys). Although Ivancic may disclose that a computer keyboard may include a processor, Ivancic does not disclose anywhere that the processor is located in a key or button of the computer keyboard.

C. Ivancic Fails To Disclose A Game Button

In addition to Jorasch failing to disclose a game button physically mounted on a gaming machine, Ivancic also fails to disclose this claim element. A careful review of Ivancic reveals that it discloses keys 14 for a keyboard (col. 4, ll. 2-4; FIG. 1), buttons or keys 24 for a remote control (col. 4, ll. 14-16; FIG. 2), buttons/keys 34 for a key pad of a mobile phone (col. 4, ll. 25-26; FIG. 3), and keys 44 of a computer keyboard (col. 4, ll. 36-40; FIG. 4). There is no disclosure regarding a game button that is physically mounted on a gaming machine.

Thus, both Jorasch and Ivancic fail to disclose a game button that is physically mounted on a gaming machine.

D. Proposed Modification Would Render Jorasch Unsatisfactory For Its Intended Purpose

Placing the gaming token 208 and its processor 42 in a place that is generally subjected to physical "pounding" by players would render the gaming token 208 unsatisfactory for its intended purpose. Accordingly, if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (V), p. 2100-140, citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

In the present case, there is no suggestion or motivation to make the proposed modification. It would defeat the purpose of a "token" to have the "token" – which is intended to be used as substitute currency – physically mounted to a gaming machine. Just like coins or other currency, tokens are intended to be free of "physically mounting."

The term "gaming token" has been specifically defined in Jorasch to include "a casino chip or other object issued by a casino for betting in a table game of chance or in a gaming device, or a token issued by a game arcade for use in a video game or other amusement game." Jorasch, col. 4, ll. 52-55. *See also* http://en.wikipedia.org/wiki/Gaming_token ("[c]asino tokens (also known as chips, checks or cheques) are small discs used in lieu of currency in casinos"; http://dictionary.reference.com/browse/token ("token coin [is] a stamped piece of metal, issued as a limited medium of exchange, as for bus fares, at a nominal value much greater than its

commodity value"). If the gaming token 208 is modified to be physically mounted on a gaming machine, it simply cannot be used as currency in a casino.

E. Claimed Game Button Is Contrary to Accepted Wisdom In The Art

The MPEP is clear that the "totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness." MPEP, § 2145(X)(3), p. 2100-168, *citing In re Hedges*, 783 F.2d 1038, 228 U.S.P.Q. 685 (Fed. Cir. 1986). Modifying Jorasch in view of Ivancic would force a skilled artisan to proceed contrary to the accepted teachings in the art.

Electronic components, such as processors, are prone to failure when subjected to physical force. The previously filed Declaration of Charles R. Bleich Under 37 C.F.R. § 1.132 ("Declaration of Bleich") provides further details regarding why a person or ordinary skill would actually be discouraged from including a microprocessor in an individual game button at the time of the invention. *See*, *e.g.*, Declaration of Bleich, ¶¶ 12-13. For example, one reason why a microprocessor would not be included in an individual game button is because game buttons are subjected to physical abuse, *i.e.*, are repeatedly "pounded on" by players. *Id.* at ¶ 13. The skilled artisan would not be motivated to modify the gaming token 208 of Jorasch to be physically mounted on a gaming machine in view of the keys 14, 24, 34, 44 of Ivancic because none of them are intended to be "pounded on" and, also, because the keys 14, 24, 34, 44 of Ivancic do not include a processor or a memory device in the keys themselves.

Jorasch discloses that a player "may provide input signals to the processor 402" by simply "squeezing or tapping the token." Jorasch, col. 7, ll. 27-30. Squeezing or tapping the gaming token 208 is far different than pounding on the gaming token 208.

Ivancic discloses keys or buttons that are intended to be simply pushed. For example, Ivancic notes that a "display 45 is not compressed when the key is pushed down." Ivancic, col. 4, ll. 46-48 (emphasis added). Nowhere does Ivancic shows anything that is "generally subjected to physical 'pounding' by the users," as alleged in the Final Office Action. Final Office Action, p. 3. Furthermore, even if it is assumed that the buttons or keys of Ivancic are intended to receive some type of physical force, none of the processors or memory devices disclosed by Ivancic are located in a key or button of a respective keyboard. For example, the processor 51 of a computer keyboard disclosed by Ivancic is located generally in the computer keyboard but not in the buttons of the computer keyboard. Ivancic, Fig. 5.

Jorasch does not even hint that the gaming token 208 can be subjected to repeated pounding. In fact, based on the disclosure in Jorasch, and consistent with common-sense knowledge, the gaming token 208 is intended for receiving minute physical forces, *e.g.*, tapping, squeezing, pushing. Contrary to the teachings of Jorasch (which are consistent with the Declaration of Bleich) and contrary to accepted wisdom in the art, the game button of the present claims is intended to be pounded on.

Consistent with the teachings of Jorasch and common sense (as stated in the Declaration of Bleich), Ivancic does not even hint that a processor or a memory device can be located in any of the disclosed keys 14, 24, 34, 44. In fact, because the keys 14, 24, 34, 44 of Ivancic are intended to receive some type of physical force, they are not intended to include a processor or a memory device.

IV. Conclusion

It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000214USP1.

Respectfully submitted,

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